

Hearing:

December 9, 1999

Paper No. 28

EWB/MM

THIS DISPOSITION IS NOT

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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Wallac, Inc.
v.
Roche Diagnostic Corporation

Opposition No. 108,085
to application Serial No. 75/172,703
filed on September 26, 1996

Gail L. Morrissey of Standley & Gilcrest for Wallac, Inc.

David E. Klinestiver of Locke, Reynolds, Boyd & Weisell for
Roche Diagnostic Corporation.

Before Seeherman, Hanak and Rogers, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Roche Diagnostic Corporation (applicant) seeks to
register HIGH PURE in typed drawing form for "biochemicals,
namely, chemical reagents for the purification of nucleic
acid for scientific or research use." The intent-to-use
application was filed on September 26, 1996.

Wallac, Inc. (opposer) filed a notice of opposition
alleging that long prior to September 1996, it both used and

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registered the mark HYPURE for agricultural testing kits, reagents, varietal identification services and genetic purity assay services. Continuing, opposer alleged that the contemporaneous use of applicant's mark HIGH PURE for applicant's goods and HYPURE for opposer's goods and services is likely to cause confusion, mistake or deception. While the notice of opposition did not make specific reference to Section 2(d) of the Trademark Act, it is clear that this is the ground upon which opposer bases its opposition.

Applicant filed an answer which denied the pertinent allegations of the notice of opposition.

Both parties filed briefs and were present at a hearing held on December 9, 1999.

The parties are in agreement as to what constitutes the record in this case. This record is summarized at pages 1-2 of opposer's brief and at pages 5-6 of applicant's brief.

At the outset, we note that priority is not an issue in this proceeding because opposer has properly made of record certified status and title copies of the following three registrations owned by opposer: (1) Registration No. 1,851,800 for HYPURE in typed drawing form for "varietal identification services and genetic purity assay services"; (2) Registration No. 1,854,991, for the mark HYPURE and design (as shown below) for the same services; and (3)

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Registration No. 1,898,458 for HYPURE and design (again, as shown below) for "agricultural testing kits for testing plant seeds and plant tissues, and electrophoretic gels, reagents, and control reagents therefor."

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.").

Considering first the marks, we note that marks are typically compared in terms of visual appearance,

pronunciation and connotation or meaning. However, in appropriate cases, sufficient similarity as to any one of the three factors can result in a finding of likelihood of confusion. Krim-Ko Corp. v. Coca-Cola Co., 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.").

In this case, we find that the critical factor in comparing opposer's registered marks with applicant's mark is pronunciation (sound). This is because both opposer's products and applicant's products are ordered primarily by telephone. On cross-examination, opposer's product manager for its HYPURE products was asked how opposer's customers typically place their orders. She responded: "Through the telephone..." (Durig deposition page 52). On cross-examination, applicant's product manager for applicant's HIGH PURE products was also asked how applicant's customers typically place orders with applicant. He responded as follows: "In general, usually telephone orders through our customer service department are by far the most common." (Martin deposition pages 79-80).

Thus, while there are dissimilarities between opposer's registered marks and applicant's mark in terms of visual appearance, these visual dissimilarities are of limited significance when the clear majority of orders for both

opposer's products and applicant's products are placed orally. Under such circumstances, it is entirely appropriate to give decidedly more weight to a comparison of the pronunciation of opposer's registered marks with the pronunciation of applicant's mark. See Krim-Ko Corp., 156 USPQ at 526 ("...Sound is of particular importance when we are dealing with products ... which may frequently be purchased by the spoken word."). See also 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 23:22 at pages 23-48 to 23-49 (4th ed. 1999) ("Similarity of sound may be particularly important when the goods are of the type frequently purchased by verbal order.").

At page 15 of its brief, applicant states that it "does not dispute that opposer's HYPURE mark and its own HIGH PURE mark are phonetic equivalents." Of course, when spoken opposer's HYPURE mark (with or without the design) also has the same meaning or connotation as applicant's HIGH PURE mark. Indeed, even when visually observed, we find that many consumers would understand opposer's HYPURE mark (with or without the design) as indicating "high pure." This is true despite the fact that opposer's product manager testified that opposer created its HYPURE mark by combining the words "hybrid" and "purity." (Durig deposition page 40). There is absolutely no evidence in the record to

indicate that purchasers of opposer's products or services would be aware as to how opposer created its HYPURE mark.

In an effort to minimize the fact that opposer's registered marks and applicant's marks are phonetic equivalents, applicant argues at page 15 of its brief that our primary reviewing Court has more recently held "that phonetic similarity alone is insufficient to establish as a matter of law that uses of the marks at issue are likely to cause confusion," citing Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). However, the Olde Tyme Foods case simply does not support the proposition for which applicant cites it. To begin with, the Olde Tyme Foods case involved the grant of summary judgment by the Board which the Court found was improper because the Board did not draw all factual inferences in favor of the non-moving party. In this regard, the Court made the following statement: "Because we are reviewing a grant of summary judgment, we do not engage in the delicate task of weighing the differences in appearance against the marks' properly found phonetic similarity." 22 USPQ2d at 1545. In addition, in the Olde Tyme Foods case, there was absolutely no evidence that the goods in question were ordered orally, and there was certainly no evidence that they were primarily ordered orally. Thus, the Court made the following observation: "Yet phonetic similarity alone is

insufficient in this case to establish as a matter of law that the uses of the respective marks are likely to cause confusion." 22 USPQ2d at 1545. (Emphasis added).

In stark contrast to the Olde Tyme Foods case, we have the admission of applicant's product manager that telephone orders (oral orders) "are by far the most common" method of ordering applicant's products. We also have the uncontroverted testimony of opposer's product manager that the typical manner of ordering opposer's products is likewise orally, by the telephone. Finally, we have the admission by applicant that opposer's HYPURE mark and applicant's HIGH PURE mark are not merely phonetically similar, but rather they are "phonetic equivalents." Thus, opposer's registered marks and applicant's mark are identical in pronunciation and connotation.

Turning to a consideration of a comparison of opposer's goods and services with applicant's goods, we note at the outset that there is no testimony or other evidence indicating that opposer's services are, like opposer's goods, ordered orally, either by telephone or otherwise. Thus, in our likelihood of confusion analysis, we will focus on a comparison of opposer's mark and goods as set forth in its Registration No. 1,898,458 with the mark and goods as described in applicant's application. We will give no consideration as to whether the contemporaneous use of HYPURE

for opposer's services and HIGH PURE for applicant's goods is likely to result in confusion.

We note that because the mark of opposer's Registration No. 1,898,458 and applicant's mark are identical in terms of pronunciation and connotation, this "weighs heavily against the applicant." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). In Shell Oil, the Court, while acknowledging that there were visual differences between applicant's mark and the registered mark, made the following observation: "The identity of words, connotation, and commercial impression weighs heavily against the applicant." 26 USPQ2d at 1688. As was the case with the marks in Shell Oil, the marks in question here have obvious visual dissimilarities. However, as was the case with the marks in Shell Oil, the marks here are identical in terms of pronunciation (sound) and, at least when spoken, connotation and commercial impression. Hence, because opposer's mark and applicant's mark are identical as they are most commonly used by customers, this means that "even when [the] goods or services [of the parties] are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source." Shell Oil, 26 USPQ2d at 1689.

Turning to a comparison of opposer's goods as described in its Registration No. 1,898,458 and applicant's goods as

described in its application, we find that as described, opposer's goods and applicant's goods are clearly related in that they could be used by the same individuals (researchers at universities and agricultural companies) to conduct or to prepare to conduct tests (albeit different tests) involving plant seeds and plant tissues.

In arguing that its goods are dissimilar from opposer's goods, applicant makes the critical mistake of focusing upon the actual goods on which it uses its HIGH PURE mark, as opposed to focusing upon the goods as described in its application for registration of its HIGH PURE mark. As our primary reviewing Court has made abundantly clear, "in a proceeding such as this, the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in an opposer's registration, rather than what the evidence shows the goods and/or services to be." Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

Thus, the following statements made by applicant at pages 16 and 17 of its brief in an effort to distinguish its actual HIGH PURE products from opposer's HYPURE products are essentially irrelevant: "More importantly, applicant's HIGH PURE products have no application to the plant sciences and

those researchers working in that specialty. Applicant's HIGH PURE products are for treating the nucleic acid of non-plant tissues and are of use primarily to medical and other biotech researchers. The dissimilarity of established, likely to continue trade channels utilized in the marketing of opposer's HYPURE products and services and applicant's HIGH PURE products is perhaps alone enough to determine that no likelihood of confusion exists. Opposer markets its goods and services through seed and food industry trade shows ... to customers in these industries. ... Applicant's target customers are end-user researchers in university and commercial laboratories that are involved in medical and biotech (and not plant-science) research. Sales are generally made by telephone calls received from the customer or his/her purchase agent ..." (Emphasis added).

Applicant's chosen description of goods in its HIGH PURE application reads as follows: "biochemicals, namely, chemical reagents for the purification of nucleic acid for scientific or research use." There is no adjective modifying the term "nucleic acid" in the foregoing description. Thus, applicant's chosen description of goods includes not only animal nucleic acid, but also plant nucleic acid. Applicant's product manager acknowledged that there is nucleic acid (i.e. RNA and DNA) in plant cells. (Martin deposition page 63). In addition, applicant's

product manager explicitly acknowledged that applicant's chosen description of goods in its application could include chemical reagents for use in connection with plant cells. (Martin deposition pages 64-65). Finally, applicant's product manager acknowledged that in actual practice, chemical reagents are used in connection with plant cells, and that indeed, applicant itself actually markets such a product, albeit under the trademark TRI PURE, and not under the trademark HIGH PURE. (Martin deposition page 64; applicant's exhibit 8, page 2).

Thus, applicant's chosen description of goods is broad enough to include chemical reagents for the purification of plant nucleic acid for scientific or research use. Such chemical reagents would, obviously, not be directed to medical researchers, as are applicant's actual HIGH PURE products. Rather, such chemical reagents for the purification of plant nucleic acid would be directed to researchers at schools of agriculture and agricultural companies. These are precisely the same entities that would purchase the goods set forth in opposer's Registration No. 1,898,458, namely, "agricultural testing kits for testing plant seeds and plant tissues, and electrophoretic gels, reagents, and control reagents therefor." See Durig deposition page 35.

Thus, a researcher in the agricultural school at a particular university could order, either directly or through a purchasing agent, both opposer's kits for testing plant seeds and plant tissues and opposer's related gels, reagents and control reagents, and applicant's chemical reagents for the purification of plant nucleic acid for scientific or research use. Obviously, opposer's goods as described in Registration No. 1,898,458 and applicant's goods as described in its application are not identical. However, they are clearly related in that opposer's testing kits are used to test the genetic purity of plants and plant seeds and to ascertain that a plant or seed of a purported variety is indeed that actual variety. (Durig deposition pages 16-17). While applicant's chemical reagents are used in the purification of nucleic acid which is then utilized in more "sophisticated" testing than are opposer's products, nevertheless, both products are utilized by the same researchers and both products are used in connection with the genetic testing of plants. The only difference is that opposer's products are used on a more elementary level and applicant's products are used in conjunction with preparing for tests at a more "sophisticated" level.

Finally, we wish to touch upon the host of arguments which applicant has raised in a very abbreviated fashion at page 18 of its brief. There is no dispute that the users of

both opposer's products and applicant's product as described in its application are sophisticated. However, given the fact that most of the orders for the products are via the telephone, and given the additional fact that the marks, as applicant acknowledges, are phonetically identical, even sophisticated purchasers could easily confuse the two. Moreover, both opposer and applicant have acknowledged that often the actual orders for their respective products are placed not by the sophisticated researchers, but instead are placed by purchasing agents. There is no evidence that these purchasing agents would be knowledgeable about the differences between opposer's reagents used for genetic testing and applicant's reagents used for the purification of nucleic acid. In addition, the users and purchasing agents for both opposer's products and certain of applicant's products as described (chemical reagents for the purification of plant nucleic acid) would be in the same sections of a university or agricultural company. To use the example of a university, the users and purchasing agents would both work for the school of agriculture, and not the medical school.

Second, with regard to applicant's argument that there have been no instances of actual confusion, we simply wish to point out that, as applicant has actually used its HIGH PURE mark, there would be no chance for actual confusion to

occur since applicant has chosen to limit its HIGH PURE product for use in connection with animal nucleic acid, and thus the users of this product would be quite different from the users of opposer's products.

Finally, as for applicant's argument that "the mark HYPURE is inherently a weak mark and should not be able to exclude nonidentical marks used for dissimilar goods," we simply note that there is no proof that HYPURE is a weak mark. Moreover, opposer's mark HYPURE and applicant's mark HIGH PURE are indeed identical marks in terms of the important factors of pronunciation and connotation. Finally, while applicant's actual HIGH PURE goods may be dissimilar from opposer's HYPURE goods, applicant's goods as described in its application are certainly not dissimilar from opposer's goods.

Of course, it need hardly be said that to the extent that there are doubts on the issue of likelihood of confusion, such doubts must be resolved in favor of opposer as the registrant and prior user. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290-91 (Fed. Cir. 1984). Moreover, it should be made clear that our finding of likelihood of confusion is premised solely upon a comparison of the mark and goods as set forth in opposer's Registration No. 1,898,458 and the mark and goods as described in applicant's application. We make no finding

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as to whether there would exist a likelihood of confusion had opposer chosen the following description for its goods: "biochemicals, namely, chemical reagents for the purification of animal nucleic acid for scientific or research use." (Emphasis added).

Decision: The opposition is sustained.

E. J. Seeherman

E. W. Hanak

G. F. Rogers
Administrative Trademark
Judges, Trademark Trial and
Appeal Board